THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ERIC J. BROWN

_____

Appeal No. 95-2070
Application 08/073,816[1]

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ON BRIEF

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Before STONER, Chief Administrative Judge, WINTERS, and WILLIAM F. SMITH, Administrative Patent Judges.

WILLIAM F. SMITH, Administrative Patent Judge.

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[1] Application for patent filed June 8, 1993. According to appellant, this application is a continuation of Application 07/706,532, filed May 28, 1991, now abandoned; which is a division of Application 07/227,972, filed May 3, 1988, now U.S. Patent No. 5,057,604.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the final rejection of claim 1, the only claim pending in the application. Claim 1 reads as follows:

1. A hybridoma cell line having the identifying characteristics of hybridoma cell line B6H12, ATCC HB 9771, and any cell line derived therefrom that produces antibodies which specifically recognize a receptor that binds to proteins that contain the amino acid sequence Arg-Gly-Asp which on binding said proteins causes the cells to become more phagocytic but which is antigenically distinct from VLA, platelet gb IIb/IIIa, Vn and LFA-1, Mac-1, p150, 95 family of receptors.

The references relied upon by the examiner are:

Hemler et al., "The VLA Protein Family," J. Biol. Chem., vol. 262, No. 7, pp. 3300-3309, 1987.

Ruoslahti et al., "New Perspectives in Cell Adhesion: RGD and Integrins," Science, vol. 238, pp. 491-497, 1987.

Ginsberg et al., "Cytoadhesins, Integrins, and Platelets," Thromb. Hemostasis, vol. 59, No. 1, pp. 1-6, 1988.

Waldmann, "Monoclonal Antibodies in Diagnosis and Therapy," Science, vol. 252, pp. 1657-1662, 1991.

Claim 1 stands rejected under 35 U.S.C. § 101 (utility), § 112, first paragraph (enablement) and § 103. The examiner relies upon Waldmann as evidence in support of the utility/enablement rejection and Hemler, Ruoslahti and Ginsberg in support of the obviousness rejection. We reverse.

DISCUSSION

1. Utility/Enablement

Having considered the respective positions of appellant and the examiner, we find ourselves in agreement with that of appellant. Accordingly, we reverse these rejections for the reasons set forth in Sections II-IV of the appeal brief (Paper No. 10, July 25, 1994).

2. Obviousness

A conclusion of obviousness under 35 U.S.C. § 103 must be based upon the claimed subject matter as a whole. Accordingly, before turning to the merits of the examiner's rejection, we must determine what subject matter is claimed in claim 1 on appeal.

We view claim 1 on appeal as having two aspects. First, claim 1 is directed to "[a] hybridoma cell line having the identifying characteristics of hybridoma cell line B6H12, ATCC HB 9771". Second, claim 1 is directed to "any cell line derived [from hybridoma cell line B6H12, ATCC HB 9771] that produces antibodies . . ."

In considering the first aspect of claim 1, the question arises as to what is meant by the phrase "identifying characteristics" since a hybridoma such as B6H12 has many identifying characteristics. Since claim 1 on appeal does not delineate any "identifying characteristics," we view this first aspect of claim 1 on appeal to be strictly limited to "hybridoma cell line B6H12, ATCC HB 9771," no more, no less. In other words, the

"hybridoma cell line" encompassed by this first aspect of claim 1 on appeal must have all the identifying characteristics of hybridoma cell line B6H12, ATCC HB 9771. There is only one hybridoma which meets that description, i.e., hybridoma cell line B6H12, ATCC HB 9771.

Turning to the second aspect of claim 1, we find this portion of claim 1 to be directed to a cell derived from hybridoma cell line B6H12, ATCC HB 9771 having the recognition and antigenic properties recited in the remainder of the claim. Therefore, for a given hybridoma to meet the requirements of the second aspect of claim 1, it must be "derived" from hybridoma cell B6H12, ATCC HB 9771 and possess the recognition and antigenic properties set forth in the remainder of the claims.

With this claim construction in mind, it becomes clear that the examiner's rejection must be reversed. In stating the rejection on pages 6-9 of the Examiner's Answer, the examiner does not explain how the applied prior art would have taught or suggested to one of ordinary skill in the art the hybridoma cell line B6H12, ATCC HB 9771. Without access to that hybridoma, it is not apparent how one would obtain a cell derived therefrom that has the recognition and antigenic properties set forth in the remainder of claim 1 on appeal. Since the examiner's rejection does not take into account the subject matter of claim 1 as a whole, it is legally insufficient and can not be sustained.

For the reasons set forth above and the reasons set forth in section V of the Appeal Brief, we reverse the rejection under 35 U.S.C. § 103.

The decision of the examiner is reversed.

REVERSED

Bruce H. Stoner, Jr., Chief Administrative Patent Judge	)
Sherman D. Winters Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
William F. Smith Administrative Patent Judge	)

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